

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

Date:	19-May-08	APPL. S. N.:	10782627
To Examiner:	RAWLINGS, STEPHEN	Art Unit	1642
From	Ford, Janice PARALEGAL SPECIALIST	Return This Memo To: Case Drop-Off Location	REMSSEN

SUBJECT: Decision on Terminal Disclaimer(T.D.) filed:

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete,

please initial, date and return this memo to me. THANK YOU.

- The T.D. is PROPER and has been recorded (see 14.23).
- The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see 14.24):
 - The TD fee of [REDACTED] has not been submitted nor is there any authorization in the application file for the use of a deposit account.
 - The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see 14.26 & 14.26.01).
 - The T.D. lacks the enforceable only during common ownership clause – needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see 14.27.01).
 - The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see 14.26 & 14.26.02).
 - The person who signed the T.D.:
 - is not an attorney "of record" (see 14.29 and 14.29.01).
 - has failed to state his/her capacity to sign for the business entity (see 14.28).
 - is not recognized as an officer of the assignee (see 14.29 & possible 14.29.02).
 - No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see 14.30).
 - The T.D. is not signed (see 14.26 & 14.26.03).
 - The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see 14.32).
 - The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see 14.26, 14.27.02 or 14.26.05).
 - The period disclaimed is incorrect or not specified (see 14.26, 14.27.02 or 14.26.03).
 - Other: [REDACTED]
 - Suggestion to request refund (see 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex.Initials: _____ Date: _____

Log Date:

Application Number 	Application/Control No. 10/782,627	Applicant(s)/Patent under Reexamination REED ET AL.
Document Code - DISQ		Internal Document – DO NOT MAIL

TERMINAL DISCLAIMER	<input checked="" type="checkbox"/> APPROVED	<input type="checkbox"/> DISAPPROVED
Date Filed : May 5, 2008	This patent is subject to a Terminal Disclaimer	

Approved/Disapproved by:

Henry D. Jefferson

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 41552
Reed, John C., et al. : Confirmation Number: 5834
Application No.: 10/782,627 : Group Art Unit: 1643
Filed: February 18, 2004 : Examiner: Rawlings, Stephen L.

For: NOVEL BAG PROTEINS AND NUCLEIC ACID MOLECULES ENCODING THEM

TERMINAL DISCLAIMER UNDER RULE 1.321

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Burnham Institute for Medical Research is the assignee of and the exclusive owner of the entire right, title and interest of, in and to the above-identified application, which is a continuation application of U.S. Serial No. 09/394,142, filed September 9, 1999, as indicated by the recordation of Assignment filed in connection with U.S. Serial No. 09/394,142, which was recorded by the U.S. Patent and Trademark Office at Reel 010375 and Frame 0958.

The Burnham Institute for Medical Research hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the above-identified application that would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154-156 & 173, as presently shortened by any terminal disclaimer, of prior U.S. Patent No. 6,696,558, which issued from U.S. Serial No. 09/394,142.

The Burnham Institute for Medical Research hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the above-identified application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the above-identified application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §§ 154-156 & 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The undersigned has reviewed all of the documents and the chain of title of the patent application identified above and to the best of the undersigned's knowledge and belief all right, title and interest in the above-identified patent application resides with the Burnham Institute for Medical Research.

- For submission on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 5. May, 2008

Respectfully submitted,

Name: Margaret M. Dunbar

Title: Director of Intellectual Property
BURNHAM INSTITUTE FOR MEDICAL
RESEARCH

Signature: Margaret M. Dunbar